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REMARKS

The abstract and specification have been amended in order to correct grammatical and idiomatic errors contained therein. No new matter has been added. Claims 1 and 3 have been amended in order to address the Examiner's rejection under 35 USC 112 and to more particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically speaking, Claim 3 now recites that the polyurethane elastic fiber nonwoven fabric has a tensile elongation of not less than 100%, a recovery at 50% elongation of not less than 75% and a tear strength per basis weight of not less than 5.5 gf. No new matter has been added.

Claims 1 and 3 have been rejected under 35 USC 112, first and second paragraphs, for not containing process limitations therein. Specifically speaking, with respect to the first paragraph rejection, the Examiner states that the specification does not reasonably provide enablement for any polyurethane nonwoven fabric comprising filaments which are fused together as well as the cited properties and with respect to the second paragraph rejection, the claims fail to set forth specific composition and structure of the polyurethane nonwoven fabric which produces the properties.

With respect to the rejection of Claims 1 and 3 under 35 USC 112, first paragraph, Applicants respectfully submit that the present claims are not directed to any polyurethane nonwoven fabric comprising filaments which are fused together. The present claims are directed to a polyurethane nonwoven fabric having a tensile elongation of not less than 100%, a recovery at 50% elongation of not less than 75% and a tear strength per basis weight of not less than 5.5 gf. It appears that the Examiner wants the claimed invention to be recited in "product-by-process" format. However, as stated in MPEP 2113, in the last paragraph under this heading, it is the patentability of the product claimed and not the recited process steps which must be established. There is no prohibition against defining a product by its physical properties. Nothing in the present specification states that the claimed product can be manufactured only by the process

steps disclosed there. The patentability of a product does not depend on its method of production. If the Examiner still adheres to the position that the currently presented claims are not enabled unless they contain the suggested process limitations, she is respectfully requested to provide case law which states that a product cannot be defined by only the physical properties thereof. In the absence of this case law, the Examiner is respectfully requested to withdraw her rejection of Claims 1 and 3 under 35 USC 112, first paragraph.

Claims 1 and 3 also have been rejected under 35 USC 112, second paragraph, as being indefinite for claiming properties of a nonwoven polyurethane fabric but failing to set forth the specific composition or structure of the polyurethane nonwoven fabric which produces the properties. Applicants respectfully traverse this rejection. The specific composition of the product is given as "polyurethane". In the case cited by the Examiner, no identification of the composition was given other than its physical properties. The Examiner is also asked to review MPEP 2164.08(c) where it is stated that, "Limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts." Product-by-process claims are proper only when the applicant cannot define his product other than by the process employed to produce it. In this particular situation, the product can be defined by the physical properties thereof. The courts have held that "a novel product that meets the criteria of patentability is not limited to the process by which it was made." Van Guard Products Corp. v Parker Hannifan Corp., 234 Fed 3d 1370, 1372-73, 57 USPQ 2d 1087, 1090 (Fed Cir 2000). The inventor of a new and useful product or article of manufacture may have a patent which covers it and gives a monopoly upon it regardless of weight variations and the method of making it. As stated previously, it is a well-recognized rule that a new product, having definite characteristics by which it may be identified, and which distinguishes it apart from the process by which it was produced, may be properly described by such characteristics,

and when so claimed and described, the claims are not limited to the process. Mauer v Dickerson, 113 Fed 870, 874 (3d Cir 1902). Therefore, Applicants respectfully submit that the presently claimed invention clearly complies with the requirements of 35 USC 112. Favorable consideration is respectfully solicited.

Claim 1 has been rejected under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over JP 09188951. In response to this rejection, Applicants are enclosing herewith a Declaration Under 37 CFR 1.132 in which a polyurethane elastic fiber nonwoven fabric was prepared according to Example 1 of JP 09188951. As shown in the enclosed Declaration Under 37 CFR 1.132, the mechanical properties of the polyurethane elastic fiber nonwoven fabric of the reference has a tear strength which is much lower than the lower limit of 5.5 gf required in the present invention. As such, it is respectfully submitted that the presently claimed invention is patentably distinguishable thereover. The Examiner is respectfully requested to reconsider the present application and to pass it to issue.

Respectfully submitted,


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Encl: Declaration Under 37 CFR 1.132
Replacement Abstract
Replacement Sections for
TECHNICAL FIELD
BACKGROUND ART
DISCLOSURE OF THE INVENTION
INDUSTRIAL APPLICABILITY
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